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Paper No. 12

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In re Application of
Durst et al.
Application No. 09/884,656
Filed: June 20, 2001
Attorney Docket No. 1578

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JUN 20 2003

OFFICE OF PETITIONS

ON PETITION

This decision concerns the June 9, 2003 "Petition to Revive Patent" which asserts timely response to an Office action and is being properly treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in this application.

The petition is **DISMISSED**.

A non-final Office action was mailed on March 25, 2002 ("3/25/02 Office Action"), setting forth a 3-month shortened statutory reply period. No response was filed on or before June 25, 2002 and no extension of time under 37 CFR 1.136(a) was obtained. The application was held abandoned as of June 26, 2002.

The instant petition asserts that a reply to the 3/25/02 Office Action was submitted to the Examiner by facsimile on May 31, 2002, and again by mail on June 7, 2002 ("6/7/02 Response"), implying that the application should not be held abandoned.

A correspondence in response to an Office action and deposited as first class mail with the USPS in accordance with the procedure set forth in 37 CFR 1.8(a) is considered timely filed in the PTO even if received by the PTO subsequent to the reply period given in that Office action. However, when a correspondence in response to an Office action is not received by the PTO, as is in the instant case, it may still be considered timely filed, provided that the party who mailed the correspondence files a petition:¹

- (1) informing the PTO of the previous mailing of the correspondence promptly after becoming aware that the PTO has no evidence of receipt of the correspondence;²
- (2) supplying a duplicate of the previously mailed correspondence showing the

¹ See 37 CFR 1.8(b).

² This condition is considered met, in that, counsel apparently informed the Examiner on 10/23/02 of the previous mailing of the reply.

original §1.8(a) certificate of mailing;³

(3) including a statement **attesting, on a personal knowledge basis** or to the satisfaction of the Commissioner, to the previous timely mailing.⁴

The petition meets the above requirements, and thus establishes that a response to the 3/25/02 Office Action was timely mailed, i.e., mailed with a June 7, 2002 Certificate of Mailing.

Unfortunately, while the Office does not dispute the assertion that a response to the 3/25/02 Office Action was timely mailed, albeit not received in the PTO, the Examiner has reviewed the 6/7/02 Response re-submitted by facsimile on 10/23/02, and determined that the response did not place the application in condition for allowance. Therefore, the application is, nonetheless, properly held abandoned as of June 26, 2002 because the timely filed amendment was not fully responsive to the 3/25/02 Office action, and was not entered.⁵ The petition is therefore dismissed, and the holding of abandonment in this application is not withdrawn.

Given that the petition refers to “unintentional abandonment,” a petition to revive the application under 37 CFR 1.137(b) should be promptly filed to revive this application, by including:⁶

- the \$650 petition fee (small entity);⁷
- a statement that the entire delay in submitting a proper reply to the 3/25/02 Office Action from its due date until the filing of a grantable §1.137(b) petition was unintentional;

and should be addressed as follows:

³ The PTO file for this application includes a copy of counsel's 6/7/02 (Certificate of Mailing date) response to the 3/25/02 Office Action, submitted by facsimile on 10/23/02.

⁴ Contained in petition.

⁵ MPEP section 711.02(a) (Rev. 1, Feb. 2003).

⁶ The Notice of Appeal and the \$160 filing fee enclosed with the instant petition satisfy the “reply” requirement of 37 CFR 1.137(b)(1).

⁷ The instant petition asserts unintentional abandonment but only encloses a \$55 petition fee, which is the fee amount for a petition under 37 CFR 1.137(a) based on unavoidable delay.

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Finally, the Office acknowledges receipt with the petition of a \$55 payment. Since no fee is required for a petition under 37 CFR 1.181, the \$55 payment will be credited toward the §1.137(b) petition should one be filed.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



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